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OFFICE OF THE DIRECTOR  
GROUP 3500

Paper No. 21

In re Application of

Joseph Hummel

Serial No. 08/424,223

Filed: April 19, 1995

For: KNITTABLE YARN AND  
SAFETY APPAREL

: DECISION ON PETITION  
: REGARDING REQUEST TO  
: WITHDRAW FINALITY

Applicant's petition, filed October 2, 1995, requests withdrawal of the finality of the first Office action mailed August 18, 1995 as being premature.

The petition is DENIED.

Applicant alleges that the first action final rejection is premature because the instant continuation was filed with a declaration under Rule 132 not previously filed in the parent application Serial No. 07/968,209 and thus a new, or different, issue exists than was previously considered by the examiner. Applicant further alleges that he was foreclosed from presenting the material after final rejection in the parent application because its inadvertent abandonment and revival left no time to file an after final response or to have such response, if filed, considered.

MPEP 706.07(b) sets forth that the claims of a new application may be finally rejected in the first Office action in those situations where (1) the new application is a continuing application of, or substitute for, an earlier application, and (2) all claims of the new application (a) are drawn to the same invention claimed in the earlier application, and (b) would have been properly finally rejected on the grounds or art of record in the next Office action if they had been entered in the earlier application. However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because either (1) new issues were raised that required further consideration and/or search or (2) the issue of new matter was raised.

A review of the record shows that a final rejection in parent application Serial No. 07/968,209 was mailed on September 7, 1994. In response to the final rejection, applicant filed a request for reconsideration on December 1, 1994. This response was considered by the examiner and an advisory action was mailed on December 14, 1994 apprising applicant of this. The parent application then became abandoned, unintentionally, and was revived under 37 CFR 1.137(b) in response to applicant's petition filed on April 19, 1995. Applicant's petition to revive was clearly granted for continuity purposes only as stated in the petition decision mailed July 20, 1995.<sup>1</sup> The instant continuation application was filed on April 19, 1995 simultaneously with the above noted petition to revive and included a declaration under Rule 132 and a preliminary communication presenting remarks addressing the Rule 132 declaration and pointing out patentability. No amendments to the claims were presented.

Applicant first asserts that a final rejection on first action is improper where the application contains material presented after final rejection but denied entry because new issues were raised that required further consideration. This is correct and, as noted above, is clearly set forth in MPEP 706.07(b). However, applicant never submitted, or otherwise gave the examiner the opportunity to consider, the Rule 132 declaration in the parent application. Thus, such material was never denied entry by the examiner as raising new issues that required further consideration.

Applicant further states that because of the facts in this case, he was "foreclosed from presenting the material after final rejection upon revival of the application" and a "continuation application was required". This is incorrect. When an Office action is made final, applicant no longer has any right to unrestricted further prosecution. This does not mean that no further amendment or argument will be considered. See 37 CFR 1.116(b), MPEP 706.07(e), MPEP 714.12, and MPEP 714.13. Thus, applicant was not "foreclosed" from submitting the Rule 132 declaration after final rejection. Further, and with respect to 37 CFR 1.137(b), applicant should note that 37 CFR 1.137(b)(1)

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<sup>1</sup>Note also that applicant chose to file a continuation application as the manner for meeting the criteria of 37 CFR 1.137(b)(1).

sets forth that a petition to revive an application unintentionally abandoned must be accompanied by either (1) a proposed response to continue prosecution of that application or (2) the filing of a continuing application, unless it has been previously filed. Applicant did not file a proposed response to continue prosecution. Rather, applicant chose to "voluntarily file a continuing application". Accordingly, no examiner, or Office, action "foreclosed" applicant from presenting the Rule 132 declaration after final rejection in the parent application. Further, there is no examiner action that is currently foreclosing applicant from submitting a response to the instant first Office action final rejection that would address or otherwise overcome the defects noted by the examiner.

With respect to applicant's remarks regarding "appropriate procedure" on page 3 of the petition, it is again pointed out to applicant that the Rule 132 declaration was not submitted in an after final response and was never refused entry on the basis of the response "raising a new issue". Further, as indicated by the examiner on page 7 of the instant first action final rejection, the Rule 132 declaration did not raise any new issues that would have resulted in the denial of entry in the earlier application had applicant exercised his option to submit such for the examiner's consideration. Accordingly, the Rule 132 declaration is not entitled to the benefits accorded an amendment denied entry in an earlier application under Office procedure because entry of such was never denied and no new issues would have been raised as stated by the examiner. The Office requirements of when a first Office action may be made final are clearly set forth in MPEP 706.07(b). The current fact situation does not establish examiner error in making the first Office action "final" in the instant application.

With respect to applicant's allegation that the final action in the parent application was premature, such allegation is moot to the issue at hand. Further, the mere allegation that the final rejection was premature is insufficient.

Finally with respect to the remarks in the third paragraph of page 3 of the petition, applicant should note that a response after final rejection is permitted and will be entered where such response *prima facie* places the application in condition for allowance or materially reduces the issues for appeal. See 37 CFR 1.116 and MPEP 714.12.

For the foregoing reasons, the finality of the first Office action is proper and no abuse of discretion or arbitrary or capricious action is evidenced.



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